

Notice of Allowability**Application No.**

10/019,094

Examiner

Robert Shiao

Applicant(s)

KAWAKAMI, JUN-ICHI

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/4, 2003.
2. ☒ The allowed claim(s) is/are 1, 5-9, 11-14, 17, now are 1-11.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1 <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 4 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>1003</u> . |
| 5 <input type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. _____. | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other _____. |

DETAILED ACTION

1. This application claims benefit of the foreign application:
Japan 11/175070 with a filing date June 22, 2000.
2. Applicant's declaration under 37 CFR 1.132, dated August 29, 2003, is acknowledged. Claims 1, 5-9, 11-14, 17, and 35 are pending in the application.

Responses to Applicant's Declaration

3. The declaration under 37 CFR 1.132 filed on August 29, 2003, is sufficient to overcome the rejection of claim 17 based upon the rejection under 35 U.S.C. 102(a). Applicants declare the unexpected results of the lyase inhibitory activity of the product naphthalene compound, which is prepared using the compound of claim 17 as the starting material. The unexpected results disclose that the IC₅₀ of the instant naphthalene compound is 4.5 times lower than that of the compared naphthalene compound. The rejection of claim 17 under 35 U.S.C. 102(a) is withdrawn.

EXAMINER'S AMENDMENT

4. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Elaine M. Ramesh on October 16, 2003. The application has been amended as follows:

In claim 5, line 4, after "is optionally", delete "protected",
and **insert**
--substituted -- .

Delete claim 35

Reasons for Allowance

5. The following is an examiner's statement of reasons for allowance:

Claims 1, 5-9, 11-14, and 17 are neither anticipated nor rendered obvious over the art of record, and therefore are allowable. The instant application relates to "Process for the preparation of imidazole derivatives". The closest reference is Gelens et al. publication, 2000, Bioorganic and Medicinal Chemistry Letters, 10: 1935-1938, discloses "Solid-phase synthesis of 4-substituted imidazole using a Scaffold approach". The difference between prior art and the instant claimed processes is that cyanoimidazole is not used as a starting material in the referenced processes. Suggestion for modification of above reference to obtain the instant claimed processes has not been found. Claims 1, 5-9, 11-14, and 17 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably


accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

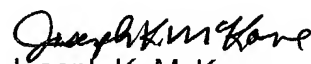
Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (703) 308-4002. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (703) 308-4537. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


Robert Shiao, Ph.D.
Patent Examiner
Art Unit 1626


Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626

October 17, 2003